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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,366	12/08/2003	Douglas B. Harwood	430140.401D1	2832
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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			ROBERTS, LEZAH	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/730,366	Applicant(s) HARWOOD, DOUGLAS B.	
	Examiner Lezah W. Roberts	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 25-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12 May 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the amendment filed January 27, 2006. The election of Group I, drawn to claims 1-9 and 25-26 without traverse has been noted and the claims will be examined on the merits. Group II, drawn to claims 10-20 directed to a method have been withdrawn.

Claims

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 contains the trademark/trade names Listerine®, Scope®, Plax® and Act®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade

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name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a mouthwash and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102 - Anticipation

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1) Claims 1, 8-9 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by McLaughlin (US 6,108,850).

McLaughlin teaches oral compositions for the whitening of teeth. The oral compositions comprise a bleaching agent, i.e. hydrogen peroxide and a catalytic agent, which accelerates the whitening effect of the bleaching agent. The catalytic agents that may be used in the compositions include activated charcoal, which is the preferred

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catalyst (col. 3, lines 8-18). The bleaching agent may be in a liquid form similar to a mouthwash, i.e. a 6% solution of hydrogen peroxide in water (col. 45-48), and the charcoal is in a powdered form, which encompasses claims 1 and 8. The two ingredients are mixed together before use (this would make an aqueous slurry) and held in the mouth for 3 to 5 minutes similar to the way one would use a mouthwash (col. 4, lines 20-32). The type of charcoal used for the compositions was activated carbon, which by definition according to "The American Heritage® Stedman's Medical Dictionary Copyright © 2002, 2001, 1995 by Houghton Mifflin Company" is "a finely powdered charcoal treated to increase its adsorptive power", encompassing what is recited in claim 9. Considering the solubility of the charcoal in water, it can be concluded the mixture forms a slurry. The compositions of the reference may be packaged in several ways. Any convenient means can be utilized for separating the bleaching agent (or liquid portion) from the catalytic agent (activated charcoal) prior to the reaction process. In one embodiment, separate containers are used, one of which holds the bleaching agent in liquid form, and one of which holds the catalytic agent in solid or liquid form. The bleaching agent is then mixed with the catalytic agent immediately prior to use. In another embodiment, a single container can be compartmentalized so the bleaching agent is housed separately from the catalytic agent. Upon extrusion from the dual compartment container the bleaching agent is combined with the catalytic agent. For example, the whitening agent and catalytic agents can each be contained in a gel or paste form. Upon extrusion from the container, the two are admixed, and placed on a toothbrush. Brushing for three to five minutes can also result in mixing the catalytic

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agent with the bleaching agent. In another embodiment, the catalytic agent may be applied to the surface of a toothbrush. A "toothbrush" is a device designed for cleaning teeth that has a region for holding, such as a handle, and a region for cleaning, such as bristles or a sponge. The toothbrush is either manually or mechanically agitated to clean the teeth of a subject. The head of the brush can be made of any appropriate material, such as plastic, and can be designed to contain the catalyst, either by applying the catalytic agent directly to the head of the brush, either on the same side of the brush as the bristles or sponge, or on the opposite side of the brush. The catalytic agent can be embedded in a fabric that is bonded to the head of the brush, or the fabric embedded with the catalytic agent can be inserted into a compartment in the head of the brush. These methods of packaging the composition encompass claims 25 and 26. The reference anticipates the instant claims insofar as disclosing aqueous slurry comprising finely-divided charcoal, water and hydrogen peroxide as a biocide. The intended use for the aqueous slurry comprising activated charcoal has no weight in determining the patentability of the instant claims because the solution of the prior art may be used for cleaning the tongue and throat of the oral cavity, as recited by the instant claims, as well as whitening the teeth as disclosed by the reference, since it is substantially the same as the Applicant's compositions.

2) Claims 1, 3-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Beerse et al. (US 6,294,186).

Beerse et al. teaches antimicrobial compositions. The compositions may be in various product forms one of which is a mouthwash (col. 9, lines 18-27) and comprise odor control elements such as activated charcoal (col. 43, lines 19-29). Alcohol and water may be carriers for the antimicrobial compositions. Preferably the carrier of the taught compositions may comprise an aqueous solution, which comprises 0 to 98.8 % water by weight of the composition. Other carriers include alcohol and depending on the type of composition, the alcohol content may range from 0 to 95 % and may contain water (col. 9, lines 28-54), which encompasses claims 3-4. Considering the solubility of the charcoal in water or/and alcohol, it can be assumed the mixture forms an aqueous slurry. The reference anticipates the instant claims insofar as disclosing an aqueous solution comprising activated charcoal, water and alcohol.

3) Claims 1, 3-4 and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Dodd et al. (US 6,344,218).

Dodd et al. discloses compositions for deodorizing the skin. The compositions comprise an effective amount of an odor-controlling agent, i.e. activated charcoal, water and 40 % to about 99 % of an alcohol antiseptic, which encompasses claims 1, 3-4 and 9. Fast acting antimicrobial agents are also essential components included in the compositions, one of which is hydrogen peroxide (col. 8, line 22), recited in claim 8. Considering the solubility of the charcoal in water or/and alcohol, it can be assumed the mixture is a slurry. The intended use for the aqueous slurry comprising activated charcoal has no weight in determining the patentability of the instant claims because the

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solution of the prior art may be used for cleaning the tongue and throat of the oral cavity, as recited by the instant claims, as well as deodorizing the skin as disclosed by the reference, since it is substantially the same as the Applicant's claimed compositions. The reference anticipates the instant claims insofar as disclosing an aqueous solution comprising activated charcoal, water, and alcohol and peroxide as the biocides.

4) Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Amick (US 4,552,752).

Amick disclose aqueous compositions comprising microbiocidal compounds and water insoluble components to control microorganisms in aqueous systems. The water insoluble components include finely-divided materials such as charcoal (col. 7, lines 55-61). The charcoal makes up 30 to 99.9 of weight of the aqueous composition, which encompasses the ratio of the instant claim 2, and the microbiocidal compound makes up 0.1 to 70% of the composition by weight (col. 4, lines 53-56). The reference anticipates the instant claims insofar as disclosing an aqueous solution comprising activated charcoal, water, and microbiocide. The intended use for the aqueous slurry comprising activated charcoal has no weight in determining the patentability of the instant claims because the solution of the prior art may be used for cleaning the tongue and throat of the oral cavity, as recited by the instant claims, as well as controlling microorganisms in aqueous systems as disclosed by the reference, since it is substantially the same as the Applicant's claimed compositions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1) Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallopo et al. (US 2001/0002252) in view of McLaughlin.

Gallopo et al. teaches oral composition for the whitening of teeth. These compositions include mouthwashes, which comprise hydrogen peroxide and other actives, as well as water up to 95% and alcohol up to 30% by weight/volume of the compositions. The reference teaches the active agents of the compositions may be added to mouthwashes already on the market. These include Listerine®, Scope®, Plax® and Cepacol® (page 5, paragraph 0066). The reference differs from the instant claims insofar as it does not disclose using finely-divided charcoal in the mouthwash compositions.

The secondary reference is discussed *supra* in the Anticipation section subsection 1. The reference teaches a catalytic agent, which accelerates the whitening effect of the bleaching agent. The catalytic agents that may be used in the compositions include activated charcoal, which is the preferred catalyst (col. 3, lines 8-18). The reference differs from the instant claims insofar as it does not disclose using a mouthwash such as Listerine® as the source of ethanol in the disclosed compositions.

It would have been obvious to one of ordinary skill in the art to have added activated charcoal to the mouthwash compositions of the primary reference motivated by the desire to accelerate the whitening effects of the bleaching agent in mouthwashes as disclosed by the secondary reference.

2) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186) in view of Butterfield (US 2,526,614).

The primary reference is disclosed above. The reference teaches composition comprising activated charcoal that acts as an odor control element. The reference differs from the instant claims insofar as it does not disclose using ammonia in the aqueous composition comprising activated charcoal.

Butterfield teaches compositions that produce ammonia when in the moisture environment of the oral cavity. Ammonia dissolves the mucin that is normally present in saliva and prevents the formation of mucin into plaques upon the tooth surfaces. When the natural protective enzyme systems have been destroyed through lowering of the pH by the activity of acidogenic organisms, mucin plaques form upon the teeth and protect

and promote the growth of colonies of bacteria which lie beneath them and also confine the acid medium necessary to the growth and development of the acidogenic organisms beneath such plaques. The ammonia formed by the disclosed invention dissolves the mucin plaques and inhibits them from reforming. The reference differs from the instant claim insofar as it does not disclose an aqueous slurry comprising water and activated charcoal.

It would have been obvious to one of ordinary skill in the art to have added ammonia to the charcoal containing compositions of the primary reference motivated by the desire to make a dentifrice that inhibits malodor in the mouth and the odor caused by ammonia and that inhibits the formation of mucin plaques as disclosed by the secondary reference.

3) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186) in view of Kesel (US 2,622,058).

The primary reference is disclosed above. The reference teaches composition comprising activated charcoal that acts as an odor control element. The reference differs from the instant claims insofar as it does not disclose using ammonia in the aqueous composition comprising activated charcoal.

Kesel teaches ammoniated dentifrices used to inhibit the growth of bacteria in the oral cavity. Ammonium salts are used in the dentifrice such as dibasic ammonium phosphate. It may be used as the sole ammonia producing ingredient or fortified by other ammonia salts (col. 6, lines 27-34). When in the oral cavity, non-acidic salts of

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ammonia produce ammonia, which inhibits *locabacilli acidophilus* in the oral cavity (col. 1, lines 1-5). The reference differs from the instant claim insofar as it does not disclose an aqueous slurry comprising water and activated charcoal.

It would have been obvious to one of ordinary skill in the art to have added ammonia salts or ammonia to the charcoal containing compositions of the primary reference motivated by the desire to have a dentifrice that inhibits malodor and the odor caused by ammonia and that inhibits the formation of *locabacilli acidophilus* as disclosed by the secondary reference

Obvious-Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 8-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/997067. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both read on an aqueous slurry comprising finely-divided charcoal, water and a biocide, i.e., alcohol and hydrogen peroxide. The copending application's claims are coextensive with the instant claims because they both read on compositions comprising charcoal, water and a biocide. The copending application further limits the biocide to either alcohol or hydrogen peroxide, which encompasses the instant claims, which recite the slurry comprises alcohol or hydrogen peroxide. The preambles are different, but they clearly overlap. It would have been obvious, in a self-evident manner, to have chosen alcohol or hydrogen peroxide from the Markush group including the same in the instant claims, given their specific recitation there. Although the instant claims also comprise ammonia, the use of the alternative indicates the ammonia may or may not be present in the compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9 and 25-26 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Frederick Krass
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